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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 3718611-01411
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Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- attorney or agent of record. **47,372**
Registration number _____
- attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Holby M. Abern

Typed or printed name

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Telephone number

December 23, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Anthony J. Baerlocher
Appl. No.: 10/649,091
Conf. No.: 4932
Filed: August 27, 2003
Title: GAMING DEVICE HAVING A MULTIPLE SELECTABLE INDICATOR GAME
Art Unit: 3714
Examiner: Matthew D. Hoel
Docket No.: 3718611-01411 (Formerly 0112300-1411)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

This request is submitted in response to the Final Office Action dated September 28, 2009 and in accordance with the telephone interview courteously granted to Applicant's representative on December 16, 2009. This request is being filed with form PTO/SB/33, "Pre-Appeal Brief Request for Review" and form PTO/SB/31, "Notice of Appeal." Applicant believes the interpretation of the prior art in the Final Office Action of September 28, 2009 rises to the level of clear error, making the case proper for pre-appeal review. Please charge Deposit Account No. 02-1818 to cover the Notice of Appeal fee set forth under 37 C.F.R. §41.20(b)(1) and any other fees due. Claims 1 to 13, 15, 16, 19 to 35, 37 to 41, 43 to 56, 103 and 125 are pending in this application.

The Examiner rejected Claims 1 to 4, 7 to 13, 15, 16, 19, 20, 22 to 35, 37 to 41, 43, 44, 47 to 54 and 103 under 35 U.S.C §103(a) as being unpatentable over U.S. Pat. No. 6,612,927 ("Slomiany") in view of U.S. Publication No. 2002/0025849 ("Olive").

Independent Claim 1 is generally directed to a gaming device which includes, amongst other elements, at least one memory device which stores a plurality of instructions which, when executed by the at least one processor, cause the at least one processor to: (a) display an award indicator including a plurality of first award symbols and a plurality of second award symbols, a plurality of first awards associated with the

first award symbols and a plurality of second awards associated with the second award symbols, wherein (i) a plurality of first activatable symbol indicators are associated with the first award symbols, (ii) a plurality of second activatable symbol indicators are associated with the second award symbols, and (iii) the first and second symbol indicators are movable relative to the award indicator; (b) enable a player to pick one of the first symbol indicators to activate the picked first symbol indicator, (c) enable the player to pick one of the second symbol indicators to activate the picked second symbol indicator, (d) cause the activated first symbol indicator to indicate one of the first award symbols on the award indicator, and (e) cause the activated second symbol indicator to indicate one of the second award symbols on the award indicator.

The Examiner admits that Slomiany lacks a plurality of second activatable symbol indicators associated with a second plurality of award symbols. The Examiner relies on Olive for its teaching of right-to-left paylines in addition to traditional left-to-right paylines. The Examiner states that Olive's right-to-left paylines are the second symbol indicators (Office Action, page 4). The Examiner concludes that it would have been obvious to modify Slomiany to include Olive's second symbol indicators (i.e., right-to-left paylines) and corresponding second award symbols to provide players with more opportunities to increase their winnings.

The Examiner has failed to address the claims that are pending in this application. During the December 16, 2009 telephone interview, the Examiner acknowledged that the currently pending claims are the claims listed in the January 30, 2009 Response to Office Action. The Examiner also acknowledged that the claims addressed in the September 28, 2009 Final Office Action are the proposed amended claims that Applicant submitted on May 18, 2009 for interview purposes only. These proposed amended claims were not entered into the record. Thus, the Examiner has not addressed the correct claims and, for this reason alone, the rejections are improper.

Regardless of whether it would have been obvious to modify Slomiany in the manner proposed by the Examiner, the resulting gaming device does not render obvious the gaming device of independent Claim 1. More particularly, the combination of Slomiany and Olive does not render obvious at least one memory device which stores a plurality of instructions which, when executed by the at least one processor,

cause the at least one processor to: (a) display an award indicator including a plurality of first award symbols and a plurality of second award symbols, a plurality of first awards associated with the first award symbols and a plurality of second awards associated with the second award symbols, wherein (i) a plurality of first activatable symbol indicators are associated with the first award symbols, (ii) a plurality of second activatable symbol indicators are associated with the second award symbols, and (iii) the first and second symbol indicators are movable relative to the award indicator; (b) enable a player to pick one of the first symbol indicators to activate the picked first symbol indicator; and (c) enable the player to pick one of the second symbol indicators to activate the picked second symbol indicator.

In formulating the obviousness rejections, the Examiner improperly employs conflicting interpretations. On page 3 of the Office Action, the Examiner interprets: (i) the 3x5 reel matrix of Slomiany as the award indicator of independent Claim 1, (ii) the rows of symbols on adjoining reels of Slomiany as the symbol indicators of independent Claim 1, and (iii) the combination of symbols displayed on each row of stopped reels of Slomiany as the award symbols of independent Claim 1. The Examiner later states that Slomiany teaches symbol indicators which move relative to the award indicator because the 3x5 matrix of Slomiany remains static while the reels are in motion. On page 4 of the Office Action, the Examiner states that Slomiany teaches enabling the player to pick one of the symbol indicators to activate that symbol indicator because Slomiany enables a player to select a number of paylines to wager on. Such inconsistent interpretations are improper and nonsensical.

Under the Examiner's first interpretation, the Examiner equates the "rows delineated by the plurality of reels" of Slomiany to the symbol indicators of independent Claim 1 (Office Action, page 3). Unlike the symbol indicators of independent Claim 1, the rows delineated by the reels of Slomiany are not moveable relative to the award indicator. For example, as seen in Fig. 2 of Slomiany, the 3x5 display matrix of Slomiany is made up of three rows and five columns. After the reels spin, the reels stop to indicate a plurality of symbols in the positions defined by rows and columns of the display matrix. Although the reels move relative to the display matrix, the rows of the display matrix do not move. Moreover, based on this interpretation, Slomiany does not

disclose enabling the player to pick a first one of the rows and second one of the rows to activate those rows. Thus, Slomiany does not disclose: (a) a plurality of first activatable symbol indicators associated with the first award symbols and a plurality of second activatable symbol indicators associated with the second award symbols, where the first and second symbol indicators are movable relative to the award indicator; (b) enabling a player to pick one of the first symbol indicators to activate the picked first symbol indicator; and (c) enabling the player to pick one of the second symbol indicators to activate the picked second symbol indicator.

Under the second interpretation, the Examiner equates the reels of Slomiany to the symbol indicators of independent Claim 1. However, Slomiany does not enable a player to pick which of the reels to activate for the game. Thus, Slomiany does not disclose: (a) a plurality of first activatable symbol indicators associated with the first award symbols and a plurality of second activatable symbol indicators associated with the second award symbols, where the first and second symbol indicators are movable relative to the award indicator; (b) enabling a player to pick one of the first symbol indicators to activate the picked first symbol indicator; and (c) enabling the player to pick one of the second symbol indicators to activate the picked second symbol indicator.

Under the Examiner's third interpretation, the Examiner equates the paylines of Slomiany to symbol indicators of independent Claim 1. Unlike the symbol indicators of independent Claim 1, Slomiany's paylines do not move relative to the award indicator. Slomiany discloses enabling a player to wager on predetermined paylines. After one or more paylines are activated, the reels spin to indicate a plurality of symbols on the paylines. Although the reels move relative to the display matrix, the paylines do not move relative to the display matrix. Thus, Slomiany does not disclose: (a) a plurality of first activatable symbol indicators associated with the first award symbols and a plurality of second activatable symbol indicators associated with the second award symbols, where the first and second symbol indicators are movable relative to the award indicator; (b) enabling a player to pick one of the first symbol indicators to activate the picked first symbol indicator; and (c) enabling the player to pick one of the second symbol indicators to activate the picked second symbol indicator.

The Examiner has pointed to nothing in Slomiany that anticipates or renders obvious a plurality of instructions which, when executed by the at least one processor, cause the at least one processor to: (a) display an award indicator including a plurality of first award symbols and a plurality of second award symbols, a plurality of first awards associated with the first award symbols and a plurality of second awards associated with the second award symbols, wherein (i) a plurality of first activatable symbol indicators are associated with the first award symbols, (ii) a plurality of second activatable symbol indicators are associated with the second award symbols, and (iii) the first and second symbol indicators are movable relative to the award indicator; (b) enable a player to pick one of the first symbol indicators to activate the picked first symbol indicator; and (c) enable the player to pick one of the second symbol indicators to activate the picked second symbol indicator. Olive also does not disclose this element and, therefore, does not remedy the deficiencies in Slomiany.

Moreover, Slomiany explicitly teaches away from the modification proposed by the Examiner. Figs. 4 and 5 of Slomiany include the following text: "ALL PAYS ARE LEFT TO RIGHT **ONLY**" (emphasis added). As Slomiany teaches away from the inclusion of right-to-left paylines, the combination of references relied upon by the Examiner is an improper basis for the obviousness rejection of independent Claim 1.

For at least these reasons, the rejection of independent Claim 1 is clearly erroneous. For similar reasons, the rejections of independent Claims 28, 47 and 103 are also clearly erroneous. Each of these independent claims and the claims depending therefrom is patentably distinguished over Slomiany and Olive. The patentability of independent Claims 1, 28, 47 and 103 renders the remaining rejections over Slomiany and Olive in view of Morris or Adams moot.

Respectfully submitted,

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